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REMARKS**Objections To The Drawings**

The Office Action at page 2 objects to the drawings stating:

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Figure 1:28, Figure 4:418, and Figure 5:506. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office Action. The objection to the drawings will not be held in abeyance.

That is, the Office Action asserts that Figure 1, reference number 28, Figure 4, reference number 418, and Figure 5, reference number 506, are not in the drawings but that the above reference sign(s) are mentioned in the description. Applicants respectfully note in response, however, that Figure 1, reference number 28, Figure 4, reference number 418, and Figure 5, reference number 506 in fact are in the drawings although not in the description.

Applicants have amended the specification to overcome the objection to the drawings. That is, Applicants in this Response amend the specification to include reference number 28 from Figure 1, reference number 418 from Figure 4, and reference number 506 from Figure 5. In addition to amending in response to the objections to the drawings, Applicants also amend to correct clerical errors. Applicants have amended a reference in the specification to number 504 from Figure 5 to correct a clerical error, and Applicants have amended claims 22 and 33 to correct typographical errors. Applicants respectfully

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submit that the present amendments present no new matter and that the present amendments therefore place the case in condition for allowance.

Claim Rejections

Claims 1-33 are in the case. Claims 1-3, 8, 12-14, 19, 23-25, and 30 stand rejected under 35 U.S.C § 102(b) as being anticipated by Blumenau (U.S. Patent No. 6,108,637). As will be shown below, Blumenau, does not anticipate online advertising as claimed in the present application. Claims 4-7, 15-18, and 26-29 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Blumenau (U.S. Patent No. 6,108,637) in view of Chang (U.S. Patent No. 6,342,893). 9-11, 20-22, and 31-33 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Blumenau (U.S. Patent No. 6,108,637) in view of Meyers, *et al.* (U.S. Pub. No. 2002/0087403). Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1-33.

Claim Rejections – 35 U.S.C. §102 Over Blumenau

Claims 1-3, 8, 12-14, 19, 23-25, and 30 stand rejected under 35 U.S.C § 102(b) as being anticipated by Blumenau (U.S. Patent No. 6,108,637). To anticipate claims 1-3, 8, 12-14, 19, 23-25, and 30 under 35 U.S.C. § 102(b), two basic requirements must be met. The first requirement of anticipation is that Blumenau must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that Blumenau must enable Applicants' claims. Blumenau does not meet either requirement and therefore does not anticipate Applicants' claims.

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**Blumenau Does Not Disclose Each and Every Element
Of The Claims Of The Present Application**

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As explained in more detail below, Blumenau does not disclose each and every element of claim 1, and Blumenau therefore cannot be said to anticipate the claims of the present application within the meaning of 35 USC 102.

Independent claim 1 claims:

1. A method of online advertising comprising the steps of:

storing in computer memory an advertisement display image assigned for display at a screen display location during a display period;

displaying the advertisement display image at the screen display location during the display period;

confirming, at a confirmation time during the display period, the displaying of the advertisement display image at the screen display location, wherein the confirming results in a determination whether the advertisement display image is fully displayed at the screen display location at the confirmation time; and

recording in computer memory the determination whether the advertisement display image is fully displayed at the screen display location at the confirmation time.

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**The Theory of Inherency Is Not Available As A
Basis For Rejection Of Claims In The Present Case**

Regarding the first and second elements of claim 1, the Office Action at page 3 states:

... Blumenau teaches a system and method of displaying an advertisement (Column 21, Lines 35-38) (inherently stored in memory) during a display period (Column 7, Lines 58-59). ...

That is, the Office Action invokes the theory of inherency as a basis for rejection of the first element of claim 1 in the present application. The Office Action takes the position in effect that some disclosure in Blumenau necessarily results in an advertisement display image stored in computer memory and assigned for display at a screen display location during a display period as described in the first element of claim 1. The rejection, however, is not accompanied by the required analysis to support a rejection relying on inherency. Merely reciting the word "inherently" is insufficient basis for a rejection on the theory of inherency. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) cited in MPEP § 2112. The Office Action does not demonstrate in any way that anything in Blumenau necessarily results in an advertisement display image stored in computer memory and assigned for display at a screen display location during a display period. In fact, such inherency does not exist. Storing in computer memory an advertisement display image assigned for display at a screen display location during a display period cannot properly be said within the meaning of *Ex parte Levy* to necessarily flow from any teaching in Blumenau. For this reason alone, Blumenau cannot be said to disclose or suggest the first element of claim 1. For this reason alone, claim 1 is patentable and should be allowed.

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**Blumenau Does Not Disclose Storing In Computer Memory
An Advertisement Display Image Assigned For Display At A Screen Display
Location During A Display Period And Displaying The Advertisement Display
Image At The Screen Display Location During The Display Period**

Regarding the first and second elements of claim 1, the Office Action states at page 3:

... Blumenau teaches a system and method of displaying an advertisement (Column 21, Lines 35-38) (inherently stored in memory) during a display period (Column 7, Lines 58-59). ...

That is, the Office Action takes the position that Blumenau at column 21, lines 35-38 and column 7, lines 58-59 discloses the first and second elements of claim 1. Applicants respectfully note in response, however, that what Blumenau at column 21, lines 33-63, in fact discloses is:

The monitoring information may be of interest not only to the content provider that provides the content for display, but to third parties as well. For example, if the content provided by the content provider includes an advertisement, the advertiser may be interested in the monitoring information regarding display of the content. The third party and the content provider may have conflicting interests in the substance of the monitoring information. For example, if the third party is paying the content provider to include the third party's content with the content provider's content, and the payment is based upon the amount of exposure of the third party's content to observers, the content provider has an interest in the monitoring information showing a large amount of exposure of the content, while the third party has an interest in the monitoring information showing a small amount of exposure. (Both parties, of course, can be simultaneously motivated by other interests, as well: for example, the third party may simply want the monitoring information to reflect accurately the amount of exposure of the content, so that they can use that information in assessing the effects of providing their content through the content provider.) If the monitoring information is transferred from the content display site to the content provider site, and unrestricted access to the monitoring information allowed at the content provider site, there may be no foolproof way to prevent the content provider from tampering with the substance of the monitoring information. This problem is particularly acute when a monitoring method according to the invention is embodied in a manner (e.g., by a Java applet), as discussed above, that necessitates that the monitoring information be transferred back to the content provider site.

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And what Blumenau at column 7, lines 58-59, in fact discloses is:

In still another aspect of the invention, in a computer system in which the content is displayed in response to an instruction that is provided from a source external to the computer system and the system for monitoring (e.g., an instruction provided by a user of the computer system), the beginning and end of a display of the content can be ascertained so that monitoring of the display of content by the computer system can begin at the beginning of the content display and end at the end of the content display. The monitoring can occur in accordance with other aspects of the invention described herein. The monitoring can also determine the duration of the display of the content. Since the occurrence of monitoring according to this aspect of the invention is coincident with the display of the content to be monitored, the monitoring expends processing capability of the computer system only when necessary, while simultaneously assuring that monitoring occurs at all times that the content is displayed.

Blumenau at column 21, lines 33-63, is a discussion of security-related issues disclosing nothing regarding an advertisement display image assigned for display at a screen display location during a display period as claimed in claim 1. In addition, Blumenau at column 7, lines 58-59, is a discussion of monitor duration, again, with no disclosure of an advertisement display image assigned for display at a screen display location during a display period as claimed in claim 1. In fact, although Blumenau mentions the beginning and end of a display of content, Blumenau at these references makes no mention of screen display location and no mention of assigning a display location for a display period. In fact, by pointing out that a user may trigger a display at an arbitrary time required for monitoring, Blumenau actually teaches directly away from display during an assigned display period as claimed here. For these reasons, Blumenau does not disclose storing in computer memory an advertisement display image assigned for display at a screen display location during a display period and displaying the advertisement display image at the screen display location during the display period as claimed in the present application. As such, Blumenau does not disclose each and every element of claim 1 and the rejection should be withdrawn.

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Blumenau Does Not Disclose Confirming, At A Confirmation Time During The Display Period, The Displaying Of The Advertisement Display Image At The Screen Display Location, Wherein The Confirming Results In A Determination Whether The Advertisement Display Image Is Fully Displayed At The Screen Display Location At The Confirmation Time

Regarding the third element of claim 1, the Office Action states at page 3:

... Blumenau teaches ... confirming the display of the advertisement on the display location (Column 7, lines 4-19). ...

That is, the Office Action takes the position that Blumenau at column 7, lines 4-19 discloses the third element of claim 1. Applicants respectfully note in response, however, that what Blumenau at column 7, lines 4-19, in fact discloses is:

In one aspect of the invention, the display of content by a computer system can be monitored by monitoring the position of the content display on a display screen of the computer system and evaluating the position of the content display on the display screen to produce monitoring information regarding display of the content. Monitoring of content display according to this aspect of the invention can be further enabled by monitoring the position of one or more other images on the display screen and comparing the position of the content display to the position of the other images to produce the monitoring information. In particular, this aspect of the invention can enable a determination as to whether (and for how long) the content display is hidden by one of the other images, and, further, whether the content display is fully hidden or partially hidden (and for how long the content display is fully and partially hidden, respectively).

Blumenau at this reference discloses monitoring, not confirming at a confirmation time as claimed in the present application. That is, Blumenau does not disclose confirming, at a confirmation time during the display period, the displaying of the advertisement display image at the screen display location, wherein the confirming results in a determination whether the advertisement display image is fully displayed at the screen display location at the confirmation time as claimed in the present application. In fact, Blumenau in discussing 'monitoring' makes no mention of a confirmation time as claimed in this case. As such, Blumenau does not disclose each and every element of claim 1 and the rejection should be withdrawn.

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**Blumenau Does Not Disclose Recording In Computer Memory
The Determination Whether The Advertisement Display Image Is
Fully Displayed At The Screen Display Location At The Confirmation Time**

Regarding the fourth element of claim 1, the Office Action states at page 3:

... Blumenau also teaches a time stamp being recorded each time the hidden state of the advertisement changes (Column 15, Lines 64-66). This is taken to read on repetition of confirming steps.

That is, the Office Action takes the position that Blumenau at column 15, lines 64-66 discloses the fourth element of claim 1. Applicants respectfully note in response, however, that what Blumenau at column 7, lines 48-65, in fact discloses is:

In still another aspect of the invention, in a computer system in which the content is displayed in response to an instruction that is provided from a source external to the computer system and the system for monitoring (e.g., an instruction provided by a user of the computer system), the beginning and end of a display of the content can be ascertained so that monitoring of the display of content by the computer system can begin at the beginning of the content display and end at the end of the content display. The monitoring can occur in accordance with other aspects of the invention described herein. The monitoring can also determine the duration of the display of the content. Since the occurrence of monitoring according to this aspect of the invention is coincident with the display of the content to be monitored, the monitoring expends processing capability of the computer system only when necessary, while simultaneously assuring that monitoring occurs at all times that the content is displayed.

Blumenau at this reference discloses monitoring, not recording in computer memory. That is, Blumenau does not disclose recording in computer memory the determination whether the advertisement display image is fully displayed at the screen display location at the confirmation time as claimed in the present application. In fact, Blumenau does not even mention or address recording anything in computer memory. As such, Blumenau does not disclose each and every element of claim 1 and the rejection should be withdrawn.

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Relations Among Claims

Independent claim 1 is patentable for the reasons discussed above. Independent claim 12 claims system aspects of the method claimed in independent claim 1. Independent claim 23 claims computer program product aspects of the method claimed in independent claim 1. Independent claims 12 and 23 therefore are patentable for the same reasons that independent claim 1 is patentable as described above. Dependent claims 2-3, 8, 13-14, 19, 24-25, and 30 depend from independent claims 1, 12, and 23, respectively. The dependent claims include each and every element and limitation of the independent claims from which they depend. The dependent claims stand because their respective independent claims stand. Claims 1-3, 8, 12-14, 19, 23-25, and 30 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1-3, 8, 12-14, 19, 23-25, and 30.

Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1-3, 8, 12-14, 19, 23-25, and 30.

Rejections – 35 U.S.C. § 103**Blumenau and Chang**

Claims 4-7, 15-18, and 26-29 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Blumenau (U.S. Patent No. 6,108,637) in view of Chang, *et al.*, (U.S. Patent No. 6,342,893 B1). To establish a prima facie case of obviousness, the proposed combination of the references must teach or suggest all of the claim limitations of dependent claims 4-7, 15-18, and 26-29. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The Office Action does not teach or suggest all of the claim limitations of claims 4-7, 15-18, and 26-29 because the rejections of claims 4-7, 15-18, and 26-29 rely on the previous 35 U.S.C. § 102 rejections. The previous 35 U.S.C. § 102 rejections argue that Blumenau discloses each and every element and limitation of independent claims 1, 12, and 23. As Applicants have demonstrated above, however,

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Blumenau does not disclose each and every element of independent claims 1, 12, and 23. Claims 4-7, 15-18, and 26-29 depend from independent claims 1, 12, and 23. Each dependent claim includes all of the limitations of the claims from which they depend. Because the proposed combination relies on the argument that Blumenau discloses each and every element of claims 1, 12, and 23 and because Blumenau in fact does not disclose each and every element of claims 1, 12, and 23, the proposed combination cannot teach or suggest all the claim limitations of claims 4-7, 15-18, and 26-29. The proposed combination, therefore, cannot establish a prima facie case of obviousness, and the rejections should be withdrawn.

Blumenau and Meyers

Claims 9-11, 20-22, and 31-33 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Blumenau (U.S. Patent No. 6,108,637) in view of Meyers, *et al.*, (U.S. Pub. No. 2002/0087403 A1). To establish a prima facie case of obviousness, the proposed combination of the references must teach or suggest all of the claim limitations of dependent claims 9-11, 20-22, and 31-33. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The Office Action does not teach or suggest all of the claim limitations of claims 9-11, 20-22, and 31-33 because the rejections of claims 9-11, 20-22, and 31-33 rely on the previous 35 U.S.C. § 102 rejections. The previous 35 U.S.C. § 102 rejections argue that Blumenau discloses each and every element and limitation of independent claims 1, 12, and 23. As Applicants have demonstrated above, however, Blumenau does not disclose each and every element of independent claims 1, 12, and 23. Claims 9-11, 20-22, and 31-33 depend from independent claims 1, 12, and 23. Each dependent claim includes all of the limitations of the claims from which they depend. Because the proposed combination relies on the argument that Blumenau discloses each and every element of claims 1, 12, and 23 and because Blumenau in fact does not disclose each and every element of claims 1, 12, and 23, the proposed combination cannot teach or suggest all the claim limitations of claims 9-11, 20-22, and 31-33. The proposed combination, therefore, cannot establish a prima facie case of obviousness, and the rejections should be withdrawn.

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Conclusion

Claims 1-3, 8, 12-14, 19, 23-25, and 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Blumenau. For the reasons described above, Blumenau does not disclose or enable each and every element and limitation of Applicants' claims. The rejections of claims 1-3, 8, 12-14, 19, 23-25, and 30 should therefore be withdrawn.

Claims 4-7, 15-18, and 26-29 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Blumenau in view of Chang, *et al.* Because the proposed combination of Blumenau and Chang relies on the argument that Blumenau discloses each and every element of claims 1, 12, and 23 and because Blumenau in fact does not disclose each and every element of claims 1, 12, and 23, the proposed combination cannot teach or suggest all the claim limitations of claims 4-7, 15-18, and 26-29. The proposed combination, therefore, cannot establish a prima facie case of obviousness, and the rejections should be withdrawn. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 4-7, 15-18, and 26-29.

Claims 9-11, 20-22, and 31-33 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Blumenau in view of Meyers. Because the proposed combination of Blumenau and Meyers relies on the argument that Blumenau discloses each and every element of claims 1, 12, and 23 and because Blumenau in fact does not disclose each and every element of claims 1, 12, and 23, the proposed combination cannot teach or suggest all the claim limitations of claims 9-11, 20-22, and 31-33. The proposed combination, therefore, cannot establish a prima facie case of obviousness, and the rejections should be withdrawn. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 9-11, 20-22, and 31-33.

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The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

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